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IN THE

Supreme Court of the United States

OCTOBER TERM, 1945

No. 370

NATIONAL ELECTRIC PRODUCTS CORPORATION,

Petitioner,

v.

TRIANGLE CONDUIT & CABLE CO., INC.,

Respondent.

**PETITION FOR WRIT OF CERTIORARI
AND SUPPORTING BRIEF**

GEORGE E. FAITHFULL,
Attorney and Counsel for Petitioner,
20 Pine Street,
New York 5, N. Y.

JOHN HOXIE,
of Counsel,
20 Pine Street,
New York 5, N. Y.



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v.

TRIANGLE CONDUIT & CABLE CO., INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Petitioner, National Electric Products Corporation, respectfully asks that a writ of certiorari be issued directed to the United States Circuit Court of Appeals for the Third Circuit to review the judgment of that court which was made finally effective by denial of a petition for rehearing on May 28, 1945 (Rec. 498, 502).

A certified transcript of the record in the case has been filed.

Summary Statement of the Matter Involved

This is a patent case in which petitioner is the patent owner and respondent is the infringer. In question here are Robinson & Moore patents Nos. 2,222,555 and 2,222,556. Because the second issued on the same day as the first,

and covered a specific form of the first, the two patents were treated as one, according to settled law, and will be so treated here. Both were held infringed but invalid.

What is patented is a combination of old elements by which an improved product was created. The court below accepted the fact that the new combination solved a problem which the active efforts of the art had not been able to solve in twenty-five years and which had stood in the way of having this wanted product. Judge Parker, dissenting, said that "there can be no doubt as to its patentability" (Rec. 494). Even the majority seem to have viewed the step which solved that problem as a "flash of genius."

The majority of the court below nevertheless held the patents invalid because, *viewing them as representing a new use of an old instrumentality*, it subjected them to an all-preclusive rule *that the new use of an old thing is not patentable* (Rec. 491). Consistent with that supposed rule, the court did not adjudge the question of invention—that is to say, the question whether the new use and resulting new product were within or beyond the reach of ordinary skill. It accepted as true, but put aside as being immaterial, all of the facts which have probative force on that question, including facts with respect to the inability of ordinary skill to solve the long standing problem and with respect to the differences in problem and in known purpose and effect between the new use of the instrumentality in question (one element of the patented combination) and its former use in association with different elements. Differences between the thing with which the instrumentality was formerly used and that with which it is used in the patented product likewise became immaterial under this supposed rule, which pre-supposes differences in that respect for otherwise it would not be a "new" use. As the inevitable consequence of these errors, the majority held the patents anticipated and invalid.

The view that the patented combination represents a new use was injected by the Court of Appeals below, neither party having presented the matter in this aspect. That view of it can not be said to be improper, although it is unusual. The sense in which it is proper is important. It involves a new use in the sense that the combination of an instrumentality with a subject with which it had not before been associated is indeed a "use" of it, and the subject being a different one, it is a "new" use of the instrumentality. In the same sense, of course, almost every new combination is a new use of any of its component elements.

The matter involved is the question whether, in such an instance of "new use," there is a preclusive rule making the new product unpatentable without more; and, specifically, whether patentability is to be determined by a *rule* precluding any inquiry into the question of the inventiveness of the new use by which the new product was created, or whether it is to be determined by a *judgment on the question of invention*, in the light of the whole evidence and the criteria fixed by this Court for such a question.

No question is raised as to the standard of invention. These patents present a classic case of invention under any standard, new or old. This is sufficiently shown by the dissenting opinion of Judge Parker which alone adjudged the question of invention, and also by the opinion of the majority who seem to have thought it a "flash of genius," but unpatentable under the supposed rule (Rec. 491).

This particular factual pattern of "new use," of the new combination species, has been presented in the past. Decisions sustaining patents for such new uses (*e. g.*, *Western Electric Co. v. LaRue*, 139 U. S. 601) establish the absence of any preclusive rule and the true determi-

nants of patentability. Those determinants appear most fully, in recent times, in the opinion of this Court in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, which recognized no preclusive rule but on the contrary marked out the inquiries that are necessary and the facts that are material to a determination of it as a question of invention on the evidence. The same principles have been expounded with especial care by Judge Learned Hand in a series of decisions in the second circuit, with which the present decision is in direct conflict.

The Subject of the Patents

As an industrial product, what is patented is an improved form of electric wire of the kind used in the wiring of buildings. No one pretends that it had existed before. In statutory terms, it is a "new and useful *** manufacture *** or new and useful improvement thereof," and the proper question is whether it fulfills the other statutory requirement that it be "invented or discovered" (35 U. S. C. § 31; *post*, p. 28, appendix). It is a combination of three chief elements, *viz.*:

1. A conductor of electricity and its insulation, conventionally copper and rubber, respectively;
2. A fibrous protective jacket around the rubber insulation to protect it and to serve as a base for coating compounds whose office is to exclude air, moisture and light, the agencies that attack rubber and cause short circuits by impairing its insulating quality; the special form of jacket here being a so-called "serving of threads," *i. e.*, a jacket formed by wrapping a number of *threads* around the insulated wire with their turns side by side, *without overlap*, to give substantially complete coverage of the rubber; and

3. A locking structure consisting of *spaced* turns of thread, preferably of rayon or nylon, wound in the opposite direction over the serving of threads at an angle of about 60°, and acting to keep the turns of threads in the serving from spreading apart and rupturing the coatings when the wire is severely bent, as in a kink.

The accomplishment was that it became possible for the first time to employ the "serving of threads" as the protective jacket on a rubber insulated wire. The serving was well known, and had had some use on bell wire and magnet wire, but it could not be used on rubber covered building wire because it was unsafe. Such a wire has to be flexible and inevitably gets twisted or otherwise severely bent, as in a kink. Kinking generates forces which cause the turns of thread in a serving to spread apart and to be forced down the sides of the kink from its apex—a sort of wedging action. Such spreading ruptures the protective compound layers, exposes the rubber to destructive agencies and leads to short circuits. A home would not be safe with such a wire in it. The Underwriters refused to approve its use. Standard practice for years therefore was to use a braided jacket, the interlaced threads of which gave a self-sustaining fabric.

But the art wanted very much to use the "serving" because it is considerably less costly than a braided jacket. Using less cotton, it gives better coverage in its single layer than does the braid with its multitude of thread cross-overs leaving little spaces between. The serving can be put on much faster; one serving machine does the work of four braiders. The serving gives a smaller diameter and a smoother surface. While not as resistant to abrasion as a braid, it is amply strong, the braid being stronger in that respect than is needed.

The art knew all of the advantages of the serving. Under the potent incentive of its known economy, it tried

to find a way to keep its turns from spreading apart under kinking forces so that those advantages could be realized. No one thought of using an outer thread counter-wound in spaced turns at the right angle, or ever conceived that a simple thread could have the capability of keeping the serving intact against the forces induced by kinking.

Three particular efforts at solution were proved, in 1913, 1924 and 1930; all unsuccessful. Most striking was that of Western Electric Co. in 1924. That company, in its manufacture of telephone wire, had the special incentive of wanting to use the serving in order to develop a continuous wire-making process in which the application of the fibrous jacket could keep pace with the application of the rubber and of the outer compound layers. The braider was too slow to fit into this process. All the Western Electric engineers could think of was to try to make the turns of the serving adhere to the rubber. They worked on various adhesives and finally developed and patented a way of vulcanizing the rubber, after applying the serving, in such a way as to get an adhesion of thread to rubber. But none of these solutions was acceptable or was used.

Robinson & Moore discovered the idea of the locking thread in 1937. After obtaining the necessary approval of the Underwriters' Laboratories, based on complete tests to establish its safety (Rec. 397-415 esp. 402-3 and 413-415; and compare 395-396 describing tests which a serving without a locking thread had failed to pass) petitioner put the wire on the market in place of the braid jacketed wire. Respondent learned of it and adopted it promptly (Rec. 156-7); hence this litigation. Three other wire companies, comprising with petitioner some 25-30% of the industry, took licenses. The experience of all demonstrates that the locking thread does the job, that

the expected economies of the serving are in fact realized, and that the long standing problem has been solved.

The known existence of the problem, the inability of the art to solve it, and its successful solution by these patentees were fully accepted by the court below. (See the majority opinion at Rec. 486-488 and the dissenting opinion at Rec. 492-493, both of which rest on the same facts.)

The opinions do not describe how the combination works, but there likewise is no dispute in that regard. When the wire is straight or but moderately bent, the serving remains intact and needs no keeper. It is self-sustaining. The action of the outer helical thread comes into play when the wire is severely bent or twisted, as in a kink. Under the influence of the bending, it exerts a clamping or locking action on the turns of thread in the serving, holding them against the rubber which furnishes the reacting force. Why the turns of the locking thread, which is but a fraction of another serving, are not themselves spread apart as the serving threads are when not so locked, we can not explain. Some complex of interacting forces is set up, the net result of which is to keep the whole covering intact so that no damage is done.

The Former Use

The use of a helical thread had been known in the industry,—“common practice *** for ages”, as one witness put it (Rec. 76)—, but never in combination with a serving of threads, or with anything analogous to it in the sense of presenting a like problem of spreading apart under forces generated by bending, or with anything that demonstrated the capability of a helical thread to perform its special office in the present combination. The discovery or conception of that capability, and its translation into practical form in the patented combination, were the inventive act.

Formerly, a helical thread was used only as a simple tie, like any string used to hold together a bundle of things that tend to tumble apart or unfold of their own accord. The particular example shown was the British Patent of Roberts, No. 242,911 (Rec. 322-324) which describes a power cable having a heavy copper conductor surrounded by two layers of thick paper insulation and an outer sheath or armor of lead. Such a cable can not be kinked or severely bent and, as the court below found, does not involve the same problem (Rec. 490).

Roberts wound a helical thread around each of his two layers of paper insulation. Each layer consists of some fifteen *flat strips* of heavy paper laid on the conductor at an angle approaching parallelism with its axis; not exceeding 11°. Each paper strip *almost completely overlaps* its fellow, to build up the thickness of the insulation. The outer lead armor holds the strips and layers of paper in place.

Roberts does not say what the helical threads are for, save as he calls them "bindings" and says they separate the respective layers. They have no purpose or effect as bindings in the finished product, because the lead armor holds everything in place. However, their effect and presumable purpose as bindings is plain enough in the light of the common practice of using a binder thread in similar situations in cable manufacture. An assemblage of bunched strands, generally longitudinal in lay like Roberts' overlapped strips, are brought together and laid in place in one operation, and the continuous outer sheath or armor is put on in a succeeding operation. In between the two operations, if there were nothing to hold them, the bunched strands would "bulge out like a balloon" (Rec. 76). In Roberts, as will appear from Figure 2 of the patent (Rec. 324), there would be a tendency for the overlapped strips to unfold sidewise of their own accord, *i. e.*, outward from the cable, somewhat

like the pages of a rolled up magazine. It presents a simple problem of bundling. To prevent such disarray, the binder thread is wound on to hold the bundle together until the lead sheath is put on, a transient purpose unrelated to any bending of the cable. Separate ties every foot or so would do, but a continuous string wound on helically is simpler to apply.

It is evident at once (1) that the *flat, overlapped strips* of Roberts' *insulation* are not concretely the same physical thing in structure or purpose as the *non-overlapping threads* of a serving used as a *jacket* for rubber insulation; (2) that the two products are different industrial things, namely, heavy power cable and flexible building wire; (3) that the problems involved in the two uses of the helical thread are of an even more different character in that the over-lapped strips tend only to unfold or bulge out sidewise of their own accord, and when the cable is straight, whereas the threads of the serving have no tendency at all to do that, for they hold themselves in place when the wire is straight or moderately bent but are forcibly spread apart *along the wire* under the wedging action set up by a sharp bend or kink; (4) that the problem dealt with by the Roberts' thread exists only during a stage of manufacture, while the different problem posed by the serving of threads arises under conditions of use of the finished product; and (5) that the Roberts' thread acts by simply containing the bundle of bulging strips, while the locking thread of the patented combination acts by a positive clamping or clinching force induced by the same bending which generates the spreading forces it opposes.

Differences in structure, in function and in purpose of use stand out. The point of identity is that each structure employs a helical thread as one element. It is in that sense that the difference can be summarized as being, in the case of the patented combination, a new use of the

helical thread resulting in the improved wire product of the patents.

The proper question posed by these facts is this: was it within the reach of ordinary skill, or beyond it, to think of using the helical thread as the thing that could keep the turns of thread in a serving from spreading apart upon kinking? Did use of a helical thread for the transient purpose in cable manufacture, as exemplified by Roberts, reveal its capability of doing what it does in the patented combination? Looking at it from the standpoint of the inner structure, was the serving of non-overlapped threads used as a jacket on a rubber insulated wire so analogous to the Roberts insulation of overlapped paper strips, in terms of problem presented and work to be done, as plainly to indicate that the helical thread was the thing to use to meet the problem of the serving?

This Court's Rule

The pertinent proposition was stated by this Court in the *Paramount* case, 294 U. S. 464 at 473, in relation to a new use of a process step. We take it that the rule can be no different for a new use of a mechanical device or expedient. This Court said: "The application of an old process to a new and *closely analogous* subject matter, *plainly indicated* by the prior art as an *appropriate subject of the process, is not invention.*" (We emphasize the words which define the necessary inquiries and subjects of evidence.)

The Decision Below

In contrast to this, the court below (even citing the *Paramount* case as supposed authority) laid down a rule that foreclosed any further inquiry: It said flatly that "The application of an old patent to a new use is not patentable" (Rec. 491). The decisive effect of this rule,

both in disposing of patentability and in shutting off any weighing of the facts material to the question of invention, is shown by the following further passage:

"Although it is true that the Robinson and Moore patents solved a long standing problem of the art, the only flash of genius to which they can be ascribed is the realization that an existing patent could be applied to a new and perplexing problem. But the observation of a new use in a prior patented device is not patentable; and the mere fact that the inventor did not use his device for that purpose or did not foresee that the purpose might be useful is immaterial" (Rec. 491).

The conflict is apparent. It is clear from this Court's proposition and mode of adjudication that if the former use is not "closely analogous", and if the new subject is not "plainly indicated by the prior art as an appropriate" one with which to use the old instrumentality, then the resulting new product or process at least *may* be patentable. It makes it a question of invention, decision of which requires just such an assessment of the evidential force of the facts bearing on the capacity of ordinary skill to solve the problem as this court made in the *Paramount* case, with the result there of finding such a plain indication in the existing knowledge as to make the new process there no invention. The rule applied below admits no possibility that any new use may be patentable and permits no weighing of the facts of probative value on the question of invention. The majority excluded as "immaterial" and "of no significance" the very facts to which this Court gives high probative force on the question, namely, (1) the fact that the old use did not involve the same problem and purpose (evidencing that it did not reveal the newly utilized capability and did not present an analogy plainly indicative of a solution in common); and (2) the fact that the patentees solved a long standing and perplexing problem which ordinary skill and better had

shown it could not solve (evidencing that no plain indication was actually conveyed by the former use).

The passage already quoted sufficiently shows that the majority below set aside as immaterial the evidence that the patents "solved a long standing problem", and that it set it aside because it thought that the "mere observation of a new use in a prior patented device is not patentable * * *".

With respect to the purpose and the known action and effect of the helical thread in Roberts, the fact that the differences were set aside as immaterial on the same ground appears summarily in the passage already quoted (*ante*, p. 11); and to a greater extent in the more detailed discussion of Roberts (Rec. 490).

After comparing the Roberts structure with that of the present patents, the majority agreed that Roberts did not assert the capability of a helical thread to do what it does in the patented combination. It agreed that Roberts' "heavy lead sheathed cable was not subjected to bends or kinks", and that the problem caused by kinking was "not before him". But the majority did not weigh these facts in relation to the question of invention. After going on to the irrelevant (because hindsight) inference that *if* Roberts' cable had been kinked it *would have had* the effect of keeping the paper strips from separating, the majority set the facts aside according to its rule, saying that

"It is of no significance that Roberts made no mention of the particular forces which his binder thread would combat or even that he did not appreciate that the binder thread would prevent separation of the spiral wrapper when subjected to a bending force."

The same idea appears in the succeeding paragraph in the statement:

"But the observation of a new use in a prior patented device is not patentable; and the mere fact

that the inventor did not use his device for that purpose or did not foresee that the purpose might be useful *is immaterial*. * * * The discovery that the Roberts binder thread possesses an unexpected advantage and accomplishes an unexpected result did not entitle Robinson and Moore, *who pointed out that fact, to a patent*. * * * The application of an old patent to a new use is not patentable" (Rec. 491; emphasis added).

It is an extraordinary mode of adjudication which no combination patent can withstand. Like the old "rules" by which patents were sustained without any critical weighing of the evidence for its true probative value on the question of invention, this new rule equally puts the determination of patentability on an arid and artificial basis. Its decisive effect in this case being clear, the case affords a proper occasion for correction in order to restore the course of the patent law to the path on which it had been put by this Court through correction of like errors in the other direction which had gained prevalence in the past.

Jurisdiction

The jurisdiction to issue the writ is founded on Section 240(a) of the Judicial Code, as amended and re-enacted by the Act of February 13, 1925 (28 U. S. Code 347(a); C. 229, Sec. 1; 43 Stat. 928).

The judgment sought to be reviewed was made finally effective on May 28, 1945, by the order (Rec. 502) denying a petition for rehearing of the judgment first entered on April 12, 1945 (Rec. 498).

The Questions Presented

1. In the case of a patent for a combination of elements creating a new and useful manufacture or improvement thereof, where the subject matter may be regarded as involving the new use of an old instrumentality forming one element of the combination, is the patent invalid in law on a rule that the new use of an old instrumentality is not patentable, precluding any inquiry as to its inventiveness, or is the question of patentability to be determined as a question of invention by a judgment as to whether, on the evidence and according to established criteria, the new use and resulting new or improved product were within the reach of ordinary skill or beyond it?
2. If the answer to the first question is that patentability is to be determined as a question of invention, then is the matter claimed in Robinson & Moore patents Nos. 2,222,555 and 2,222,556 an invention?

Reasons Relied Upon for Allowance of the Writ

1. The decision of the court of appeals below is in conflict with the applicable decisions of this Court and is in conflict with decisions of other circuit courts of appeals, notably those of the Circuit Court of Appeals for the Second Circuit, in that it applied to these patents a rule that the new use of an old instrumentality is not patentable and did not determine patentability by a judgment on the evidence as to whether the new use in combination was an invention, but held immaterial the accepted facts of probative force on that question.
2. The error sanctioned and the conflict thus created involve a matter of importance and of wide application in the administration of the patent law.

Wherefore, petitioner respectfully asks that a writ of certiorari be issued to the United States Circuit Court of Appeals for the Third Circuit to review its judgment on the patentability of the subject matter of Robinson & Moore patents Nos. 2,222,555 and 2,222,556, to the end that that judgment may be reversed.

GEORGE E. FAITHFULL,
Attorney and Counsel for Petitioner,
20 Pine Street,
New York 5, N. Y.

JOHN HOXIE,
of Counsel,
20 Pine Street,
New York 5, N. Y.,

August 24, 1945.

BRIEF IN SUPPORT OF PETITION

Opinions of the Courts Below

The opinion of the district court appears in the certified transcript of record at pages 417-424 and is reported in 56 F. Supp. 979.

The majority opinion of the circuit court of appeals appears at pages 486-492 of the transcript, and the dissenting opinion of Judge Parker appears at pages 492-497. They are reported at 149 F. 2d. 87.

Jurisdiction

1. The case is within the judicial power of the United States courts because it is an action brought under the Declaratory Judgments Act (Section 274-D of the Judicial Code; 28 U. S. C. § 400) for a declaration upon the question of validity and infringement of United States Letters Patent, a question arising under the Constitution and laws of the United States.

2. Jurisdiction of this Court is conferred by Section 240(a) of the Judicial Code, 28 U. S. C. § 347(a), as amended February 13, 1925 (C. 229, Sec. 1, 43 Stat. 938).

3. The court of appeals on May 28, 1945 denied a petition for rehearing of the decision of April 12, 1945.

Statement

The facts, and the nature and effect of the decision below, are sufficiently stated in the petition.

Specification of Errors

If the writ is allowed, petitioner will urge (1) that the circuit court of appeals erred in applying a supposed rule that the new use of an old instrumentality is not patentable, (2) in not determining patentability by a judgment on the question of invention, (3) in holding immaterial certain facts probative of invention, and (4) in not holding the patents valid.

Summary of Argument

The importance of review is so plain as not to need argument at length, and therefore in the argument proper we confine ourselves to an exposition of cases which sufficiently show (1) the failure below to follow the applicable decision of this Court, and (2) the conflict with decisions of the Second Circuit Court of Appeals and other courts of appeals.

Resolution of this conflict is important not simply for the usual reason that the effective administration of the law is impaired by a conflict and consequent uncertainty at any point. There is greatly added importance here because, in the exact sense in which the patents here are an instance of "new use", *every* patent for a combination of old elements is such an instance (*post*, pp. 23-24) and therefore is invalid without more if adjudicated in the Third Circuit but remains open to proof of invention and consequent validity if adjudicated elsewhere. The principle that a new combination of old elements may be patented—if *inventive*—is of such long and fixed standing,* and is the basis of such a large proportion of existing patents, that any invasion of it warrants review by this Court.

* This established principle has statutory sanction in the words "machine, manufacture" since most new machines and many manufactures are combinations of elements, each individually old; it may even be true in the case of the atomic bomb.

ARGUMENT

POINT I

The decision of the Court below is in conflict with, and failed to follow, the applicable decisions of this Court.

This Court has sustained patents which represented new uses of old things, in precisely the sense of the present patents, so it is plain without more that there is no rule such as was applied below. The two leading cases, illustrating the two types of patentable "new use" invention, are *Western Electric Co. v. LaRue*, 139 U. S. 601 and *Potts v. Creager*, 155 U. S. 597.

The absence of any preclusive rule is shown as well by cases in this Court in which patents of the same sort have been held invalid, not on a rule, but on a judgment of no invention in the conception of the new use. The decision in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, is a demonstration of that. The decision in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 may be viewed in that light also, since it presents the same aspect of "new use" that is involved here. It too rests squarely on a judgment of no invention.

In all of these cases, whether the patent was sustained or not, this Court recognized the materiality of precisely the kind of facts that were held immaterial below. And in *Goodyear v. Ray-O-Vac Co.*, 321 U. S. 275 at 279, this Court has again affirmed the probative force of evidence that the patentee solved a problem which ordinary skill had shown it could not solve.

In *Western Electric Co. v. LaRue*, 139 U. S. 601, the patent covered an improved telegraph instrument. The improvement lay in the use of a flat torsion spring as the

mount for the key. It was claimed in combination with the key and the supports for the spring, as a combination making the improved instrument. A torsion spring had been used before in clocks and elsewhere, but in none of those uses had there been any problem or purpose analogous to that involved in a telegraph instrument. On all the evidence, the new use producing the improved instrument was held to be an invention because not plainly suggested by the former uses.

Potts v. Creager, 155 U. S. 597 illustrates another type of patentable new use, not the new combination type but the use of an entire old machine with minor structural adaptation to a new use. There the patent covered a machine for disintegrating clay, comprising a rotating drum with ribs on its surface for working on the clay, and a co-acting member against which the clay was worked by the ribs. A structure identical in all respects, except that the ribs were of glass instead of steel, had been used before for polishing wood. The patent was sustained because it was regarded as inventive to conceive that a machine of that character was the one to use for disintegrating clay.

It was expressly held that the substitution of the steel ribs for the glass ones would not itself sustain a patent if the former use had been analogous (155 U. S. at 604 and 608). The difference in problem and purpose in the former use, and the fact that the new use had escaped the efforts of the clay art to cope with its problem, were facts that were given decisive weight on the question of invention, the very facts held immaterial here.

The rule applied below would have required invalidation of the patent in each of those cases. Conversely, had these decisions been followed below, no preclusive rule would have been applied; judgment of the question of invention would have been required; and in that judgment the facts that were held immaterial below would have dem-

onstrated the inventiveness of the patented product. The conflict is direct and plain.

The case of *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, is of especial moment here because the majority below cited it (Rec. 491) for the proposition that "the application of an old patent to a new use is not patentable". So far from making such a rule, the opinion in that case shows clearly that such a case as this must be decided by a judgment on the question of invention, which may go either way depending on the facts, especially the facts about differences in known purpose and effect and about prior efforts at solution.

The patented process there was for the preparation of a talking picture film, carrying both sound and picture on a single film, by separately exposing the sound and the picture tracks, separately developing them, and then jointly printing them on a single film for projection. In picture photography, without sound, it was known to separately expose and develop two pictures, for the *same purpose* of doing each in the best way for it, and then to print both on a single positive film, called a combination picture. The novelty of the patented process therefore was in applying to a sound-picture film the joint printing technique already known and used for the same purpose with a combination picture film. It was a "new use", in the exact sense of the term here, but it resulted in a new process in the statutory sense and so presented a question of invention.

This Court did not determine the question of patentability by invoking a preclusive "rule", to the disregard of the evidence, as did the majority below; and it expounded no such rule as that for which the majority below cited the *Paramount* case (Rec. 491). This Court proceeded to examine the question of invention. Its determinants on that question appear from the stated proposi-

tion that: "The application of an old process to a new and closely analogous subject matter, plainly indicated by the prior art as an appropriate subject of the process, is not invention" (*id.* 473, emphasis added).

This is the only rule. It does not preclude, but requires, a judgment on the question of invention, and it gives materiality to the facts held immaterial below.

Applying that test in the *Paramount* case, this Court found the analogy to the old combination picture to be close, when measured in terms of the problems and purposes involved; and, considering the historical evidence, it found no evidence that ordinary skill had tried and had proved unequal to the task. The conclusion therefore stood that "it required no more than the expected skill of the art of photography to use an old method of printing photographically the two negatives upon a single positive" (*id.* 473). That was a judgment on the question of invention.

POINT II

The decision of the court below is in conflict with decisions of other circuit courts of appeals, notably the Circuit Court of Appeals for the Second Circuit.

Conflicting decisions in the second circuit are the following:

Hartford v. Moore, 181 Fed. 132 (D. C.)*;
Hookless Fastener Co. v. G. E. Prentice Mfg. Co.,
 68 F. 2d 940 (C. C. A. 2);
Gillman v. Stern, 114 F. 2d 28 (C. C. A. 2).

* That the law as applied in the third circuit was formerly in accord with that of the second circuit is shown by the express approval of the opinion in *Hartford v. Moore* by the Court of Appeals for the Third Circuit in *Westen Mfg. Co. v. Hartford*, 194 Fed. 875, 877. See, also, *Low v. McMaster*, 266 Fed. 518 (C. C. A. 3) and *Globe Knitting Works v. Segal*, 248 Fed. 495 (C. C. A. 3).

The proposition applied in each of these cases is that there is no rule against the patenting of a new machine or process that represents in its basic conception a new use of an old instrumentality, and that if there is any novelty of structure, whether in the form of combination with new elements (the type of *Western v. La Rue*, *Paramount v. Tri-Ergon*, and the present case) or of minor adaptation (the type of *Potts v. Creager*) the sole question is that of invention in the conception or discovery of the new use. Moreover, these cases recognize that the rule applied here by the court below would make all combinations of old elements unpatentable, and they explicitly reject that rule.

In *Hartford v. Moore*, 181 Fed. 132, the patent covered an improved shock absorber for a vehicle. It was based on the use of rotating friction surfaces which would act in either direction to modify the action of the vehicle spring, either on the bump or the recoil. These friction elements were claimed in combination with the spring. Such means had been used before to modify the action of a door spring, but acting only on one direction of spring movement, there being no rebound. Judge Hand found that it was "**** the very kernel of the invention to select rotary friction as a suitable means of solving this problem" (*id.* 135). He said (*id.*, 136-137):

"Therefore a plausible argument may be made that the patent in suit is nothing but a new use for this old instrument without modification except that of size, which, of course, would be readily suggestible to any trained person. Yet, in spite of this similarity, I do not consider that it is a valid anticipation, because some one must have selected it for the purpose, and, as I have already said, the novelty of selection is oftentimes, a sure sign of patentable invention. * * * The device on doors was used to modify the action of a spring as it uncoiled and it had no use such as the patent in suit has. Therefore, neither the matter nor actual problem was at all similar to

that of the complainant's here, and it seems to me as much an invention to apply that kind of device to these circumstances as it was to apply the principle of friction calipers. Were not the novelty of the application a valid test of patentability, no strictly combination patent could be valid, for in all such patents each element is old, and it may be said that each element is simply applied to a new use. Union Sugar Refining Co. v. Mathiesson, Fed. Cas. No. 14,397; Hailes v. Van Wormer, 20 Wall. 353, 368, 22 L. Ed. 241; American Tobacco Co. v. Streat, 83 Fed. 701, 703, 28 C. C. A. 18. The formative conception of the application of old elements to a new purpose in which they are mutually interdependent requires more than a commonplace mind."

Moreover, as showing the conflict as to the materiality of the facts about prior inability to solve the problem, which the court below held immaterial here, we note the following (*id.* 137):

"Among the problems which have from the outset most troubled inventors was to modify the shocks resulting from high speed over rough roads, particularly in this country where the roads are bad. Especially was this true since the problem of spring shocks was connected with that of tires, the most difficult of all. This device has in a measure solved part of the difficulty of spring reaction, and, if the solution was obvious, why did no one of these skilled mechanics who have studied the machine inch by inch and screw by screw discover so simple a device? The pressing need for it existed for quite five years before it was discovered to the public. This is after all the best test of whether it was in the reach of the ordinary skilled artisan, and the defendant has contributed its own quota of assent to the utility of the device by what we are taught to be the sincerest commendation—a very frank imitation."

In *Hookless v. Prentice*, 68 F. 2d 940, at 941, the patent was for a combination of a well known cam lock with a

"zipper." On the particular facts of the case, it was sustained on being given the benefit of the doubt (*id.* 941). But what is significant here is the discussion of the law respecting new use. Judge Hand, speaking for the court of appeals, said (*id.* 941):

"In all such cases where the mere idea of combining old elements is the whole of the invention, we have often said that we look rather to the history of the art than to our own divinations of what was easy and apparent.

* * * * *

"The defendant insists that there can be no invention in using for a new purpose a well known device; it particularly relies upon Stearns & Co. v. Russell, 85 F. 218 (C. C. A. 6). The dispute is one of the oldest in the patent law and the decisions so numerous, on one side and the other, that discussion of them would not be very fruitful. We conceive the rule to be that if the invention be merely of a new use for an old machine, it is never patentable; the statute does not authorize patents for uses, though processes come close aboard at times. But if the patent be for a new machine, there is no such doctrine, and indeed could not be, because substantially every machine is sure to be composed of old elements. The real difficulty is, as it usually is, in fixing the marches where these conflicting doctrines meet. When may one speak of a combination of elements as a 'machine'; when is such an effort abortive, in spite of an inducement such as appears in many claims; 'in a combination,' etc.; or 'in a machine for doing so and so'? Certainly such verbiage will not always avoid the objection that the patent is merely a new use; one could not get a claim for unbreakable glass in a Pullman sleeping car by beginning, 'in a communal vehicle for the dormitory accommodation of nocturnal viators,' etc. We conceive that the question in the end depends upon whether the putative unity is factitious; whether the elements can fairly be said as a whole to constitute a 'machine, manufacturer, or composition of matter.' Rev. St. § 4886

(35 U. S. C. A. § 31). There can be no doubt in this case that, so tested, the lock is only one part of a true machine, which people would think of, and use, as such. Such a canon alone can in this instance avoid the barren dialectic which pervades so much of the patent law."

Recently in *Gillman v. Stern*, 114 F. 2d. 28 at 29-30, Judge Hand applied the same proposition to a case of adaptation to a new use, of the type of *Potts v. Creager*, the patent being for a pneumatic quilting machine in which yarn was blown into pockets in the fabric by air introduced through a hollow needle having a smaller tube within it through which the yarn was fed. He said:

"The art contained nothing of the kind before except Haas' machine, of which more later. It is true, it had been common practice in many arts to introduce an air blast around the outside of a hollow tube introduced into the entrance of a larger tube through which the air escaped, and by this means to suck material from the smaller, through the larger, tube. The Venturi carbureter is an example of this; the circle of swiftly moving air entering the larger tube creates a vacuum at the end of the smaller and sucks the gasoline forward to make the mixture. The first attack upon the patent is that it was merely for a new use of an old device. However, the only objection to patenting a new use is that the statute, § 31, Title 35, U. S. Code, 35 U. S. C. A. § 31, does not include 'uses' among what can be patented, except so far as they are included within 'arts'—i. e., processes. If, however, an old article must be physically changed, even slightly, to fit the new use, it becomes itself a new 'machine' or 'manufacture,' and the statute is satisfied. In that case the only question open is whether the discovery of the new use demands enough original thought to be deemed an invention. Constitutionally only 'discoveries' can be patented at all, and the ingenuity needed for the new conception, not the amount of physical readjustment, is the test of a valuable 'discovery.'

Topliff v. Topliff, 145 U. S. 156, 163, 164, 12 S. Ct. 825, 36 L. Ed. 658; C. & A. Potts & Co. v. Creager, 155 U. S. 597, 608, 15 S. Ct. 194, 39 L. Ed. 275; Rockwood v. General Fire Extinguisher Co., 2 Cir., 8 F. 2d. 682, 686; Gordon Form Lathe Co. v. Walcott, 6 Cir., 32 F. 2d. 55, 58."

Conflict exists also with decisions of other circuit courts of appeals, for in none is there any instance of decision by the rule applied below in this case. It is universal in other circuits to determine patentability by a judgment on the question of invention. Indeed, that question is commonly made decisive even when the patent presents nothing new except the use and when the principle expounded by Judge Hand would make such things unpatentable as not within the statute, without regard to inventiveness. The cases from other circuits cited in the opinion below do not support the majority's view. The following cases sufficiently show that the decisions of other courts of appeals are in conflict with that below.

Victor Cooler Door Co. v. Jamison Cold Storage Door Co., 44 F. 2d 288, C. C. A. 4, involved a patent on a factitious combination, really only a new setting for an old thing where the old instrumentality was an independent entity which performed only its usual office and had no interaction with the new setting to produce a new machine or manufacture in the statutory sense. It was disposed of however as a question of invention, none being found, in an opinion by Judge Parker which is altogether consistent with his dissenting opinion in this case. (See especially, 44 F. 2d at 294-295.)

Herman v. Youngstown, 191 Fed. 579, C. C. A. 6, sustained a patent on a new combination which represented a new use of an old instrumentality, the problem and purpose being different and not suggestive of the new use. (See especially, *idem.*, p. 582.) See also *Willett Mfg. Co. v. Root Spring Scraper Co.*, 55 F. 2d 858, 859

(C. C. A. 6). The opinion of the same court in *Standard Parts, Inc. v. Toledo, etc. Co.*, 93 F. 2d 336, at 337 (C. C. A. 6), expressly recognized that a product representing a new use may be patented if the concept of the new use is inventive. It found it not so in the case before it. Its decision was affirmed by this Court (307 U. S. 350) on the ground of no invention without considering it in the aspect of "new use".

Elsewhere, see *Standard Oil Co. v. Globe Oil & Refining Co.*, 82 F. 2d 488, 493, C. C. A. 7; *Wayne Mfg. Co. v. Benbow-Brammer Mfg. Co.*, 168 Fed. 271, 277-278, C. C. A. 8; *In re Prescott*, 71 F. 2d 162, C. C. P. A.; *In re Kylstra*, 87 F. 2d 487, C. C. P. A. and *Levin v. Coe*, 132 F. 2d 589, 595-597, C. A., D. C. The last cited case shows the generally accepted interpretation of this Court's decision in the *Paramount* case, *supra*, and is in direct conflict with the interpretation of it in this case by the court below.

Conclusion

Direct conflict has been created on a concrete point of patent law of importance and wide application. Allowance of the writ is justified.

Respectfully,

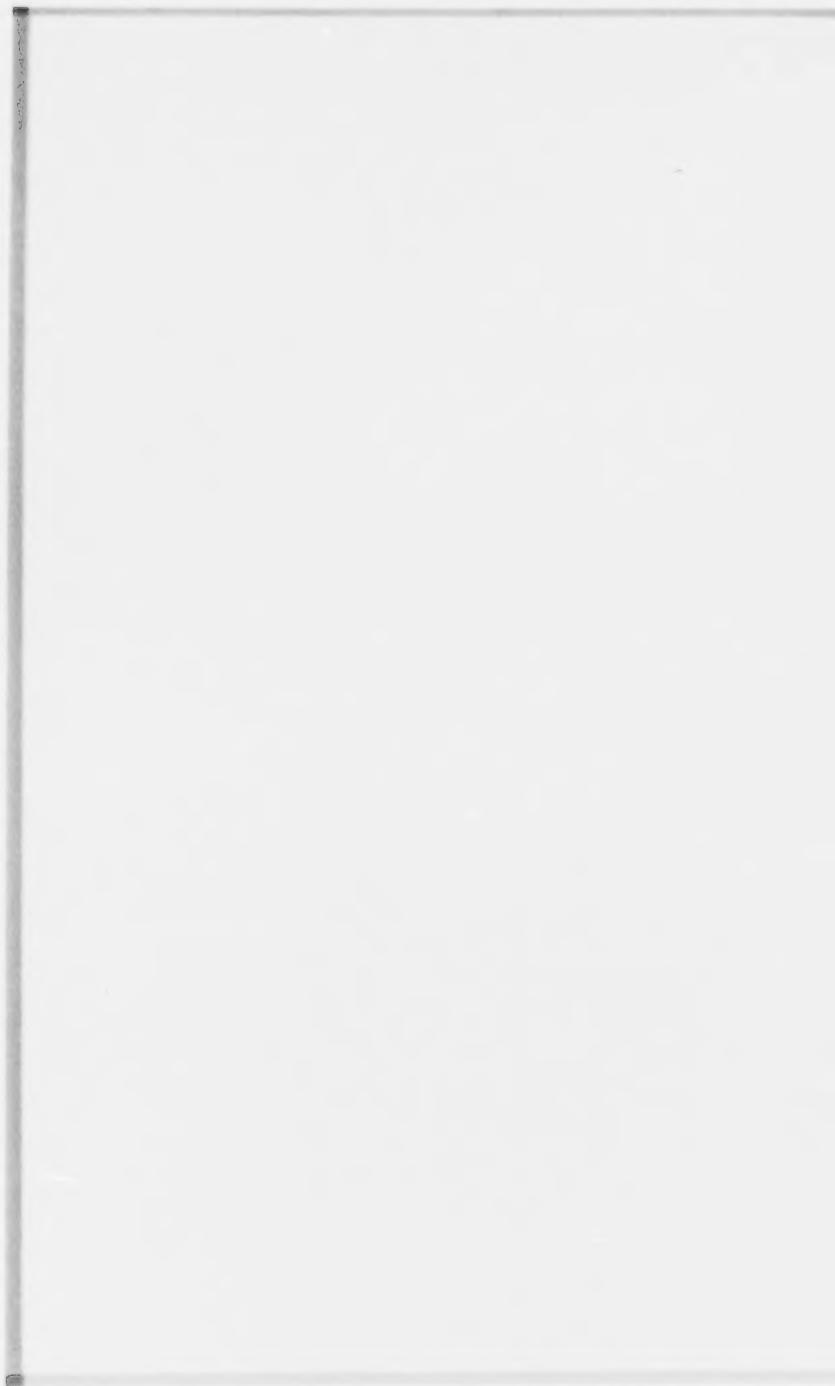
GEORGE E. FAITHFULL,
Attorney and Counsel for Petitioner,
20 Pine Street,
New York 5, N. Y.

JOHN HOXIE,
of Counsel.

August 24, 1945.

Appendix**35 U. S. C. Sec. 31**

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. § 4886; Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692; May 23, 1930, ch. 312, § 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212.)”



(3D)

FILED

AUG 29 1945

CHARLES E. WOODWARD
CLERK

IN THE

Supreme Court of the United States

October Term 1945.

No. 370

NATIONAL ELECTRIC PRODUCTS
CORPORATION,

Petitioner,

vs.

TRIANGLE & CONDUIT CABLE CO., INC.
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

SAMUEL E. DARBY, JR.,
Counsel for Respondent.

FLOYD H. CREWS,
Of Counsel.



IN THE
Supreme Court of the United States

October Term 1945.

No. 370

NATIONAL ELECTRIC PRODUCTS CORPORATION,
Petitioner,
v.s.

TRIANGLE & CONDUIT CABLE CO., INC.,
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION
TO PETITION FOR WRIT OF CERTIORARI.**

This is a patent infringement suit involving the usual issues of validity and infringement.

The patents involved were held to be invalid by the District Court for the District of Delaware and by the majority of the Third Circuit Court of Appeals below. There has been no other adjudication of the patents and, therefore, there is no diversity of opinion with respect to them. Accordingly, the petition should be denied. (*Layne and Bowler Corp. v. Western Well Works*, 261 U. S. 387, 393; *Keller v. Adams Campbell Co.*, 264 U. S. 314, 319; *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175, 178-179.)

The highly fanciful puffing of the patents in the petition, and the asserted question of law used as a pretext for arguing the merits, are both based upon the theory that the pat-

ents disclose a new combination of elements. This is not the fact. The District Court said (R. 420):

"I therefore find that patent No. '555 is invalid, first because anticipated by Roberts' British patent [R. 322] and second, if not fully anticipated, then because such slight and immaterial novelty as it presents does not involve an inventive advance.

"The second Robinson and Moore patent '556 falls with the first. Even if the first were valid, the selection of such a well-known material as it describes could not, in my judgment, possibly constitute invention."

The Court of Appeals said (R. 489):

"The Roberts patent effectively negatives any novelty in the Robinson and Moore patents and is clearly an anticipation thereof."

The question of law presented in the petition is therefore not present in the case.

Conclusion.

The petition should be denied.

Respectfully,

SAMUEL E. DARBY, JR.,
Counsel for Respondent.

FLOYD H. CREWS,
Of Counsel.

Dated: New York, N. Y.
August 28, 1945.





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SEP 1 1945

CHARLES ELMORE GROPLEY
CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1945

No. 370

NATIONAL ELECTRIC PRODUCTS CORPORATION,
Petitioner,
v.

TRIANGLE CONDUIT & CABLE CO., INC.,
Respondent.

PETITIONER'S REPLY BRIEF

GEORGE E. FAITHFULL,
Attorney for Petitioner.

JOHN HOXIE,
of Counsel.



IN THE
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NATIONAL ELECTRIC PRODUCTS CORPORATION,

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TRIANGLE CONDUIT & CABLE CO., INC.,

Respondent.

PETITIONER'S REPLY BRIEF

The conclusion of the court of appeals below, quoted by respondent, was not that the patented combination is not a new combination. The grounds of this conclusion as stated in the opinion show that to be so (Rec. 489-491): indeed, it is sufficiently shown by the treatment of the combination as a *new* use of the helical thread (Rec. 490-491). The use could not be new unless it was a use with different inner elements, making a new combination.

The conclusion of anticipation was inevitable, on the rule applied below (Pet., pp. 2-3). Rejecting that rule, the Second Circuit has recognized that consequence of it, saying "no strictly combination patent could be valid * * *" (Pet. Brief, p. 23; and 17, 23-24). Therein lies the conflict and the importance of review by this Court.

Respectfully,

GEORGE E. FAITHFULL,
Attorney for Petitioner.

August 31, 1945.